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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,676	11/12/1999	EDWARD L. BLACH	12460.1USC4	9726
23552	7590	11/04/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DAWSON, GLENN K	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 11/04/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/438,676 Examiner Glenn K Dawson	Applicant(s)
	BLACH ET AL.
	Art Unit 3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 22-46 and 48-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 22-46 and 48-58 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03-12-2004.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22-46 and 48-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaudry-6470883 in view of applicant's own disclosure of Cook.

Beaudry discloses a nasal epidermal lifting mechanism positionable on skin of either humans or animals. The nasal dilator has an adhesive layer and a support layer having one or two support members 22. However, its use on horses to treat respiratory disorders or EIPH is not specifically disclosed.

The applicant maintains on page 3 of the specification that it was at least hypothesized that EIPH was caused by asphyxia due to a closed upper airway. Cook states that pulmonary edema will occur in any horse that breathes against abnormal resistance of a closed or partially closed upper airway defined as the airway between the nostrils and the windpipe. One skilled in the art would recognize that nasal dilators are commonly used to hold open or open up blocked passages just above the nostrils. Of course this would constitute or cause an abnormal blockage or partial restriction of the airway and therefore cause abnormal resistance to breathing. It would have been obvious to have used the nasal dilator or Beaudry on an animal/horse afflicted with EIPH, as Beaudry discloses that this increases the airway to the lungs. To use the device on an animal/horse afflicted with or susceptible to other known respiratory

disorders would have been obvious as well to again increase the available air to the lungs.

To use 3 lift members instead of one or two would have been obvious as being a mere duplication of known parts.

Any decrease in respiratory impedance would have been obvious as this is the clear intent. The specific reduction claimed would have been obvious to one skilled in the art to maximize the effectiveness of the use of the device to obtain the greatest benefit possible.

Response to Arguments

Applicant's arguments filed 03-12-2004 have been fully considered but they are not persuasive.

The applicant's arguments regarding the non-enablement of the dilator of Beaudry on an animal or horse is not persuasive. One skilled in the art given the disclosure would be led to try the device on any animal. There is no disclosure that would lead one to believe that the dilator when appropriately sized and then used on a horse would be inoperative.

The fact that Cook may have targeted the throat does not mean that the earlier broader description of the nostrils to the windpipe should be ignored. The totality of what is disclosed is the overriding factor. Even though Cook may not have arrived at the same solution to treating the problem, the disclosure of Cook recognizes a problem and arrives at a theory for its cause. Cook may not have had the benefit of the knowledge that dilators for horse's nasal passages were known. In any event, Beaudry provides the

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impetus for using a dilator on an animal; the prior art is full of nasal dilators for horses (albeit the previous dilators were inserted into the nasal passages) and therefore, the examiner contends that there is sufficient evidence that one skilled in the art would have found it obvious to have used a nasal dilator, such as that disclosed by Beaudry, on a horse to treat EIPH or any other respiratory ailment caused or exacerbated by restricted airways.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K Dawson whose telephone number is 703-308-4304. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 703-308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn K Dawson

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Primary Examiner
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Gkd
31 October 2004